

03-11-05

AF 1111

Express Mail Label No.: EV458034732US

10209-00007

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eugene A. Fusz

: Art Unit: 3623

Serial No.: 09/426,954

: Examiner: Boyce, Andre D.

Filed: October 26, 1999

:

For: METHODS AND APPARATUS FOR  
ANONYMOUS DATA PROFILING

:

AMC

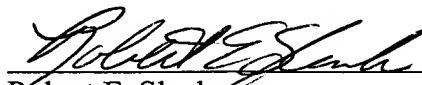
**TRANSMITTAL LETTER ACCOMPANYING APPELLANT'S REPLY BRIEF**

Mail Stop: Appeal Brief - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Transmitted herewith in triplicate is a Reply Brief in this application.

It is believed no fees are required. However, in the event of a determination otherwise, charge any deficiency to Deposit Account No.01-2384. This transmittal letter is submitted in duplicate for this purpose.

Respectfully submitted,

  
\_\_\_\_\_  
Robert E. Slenker  
Reg. No. 45,112  
Armstrong Teasdale LLP  
One Metropolitan Square  
Suite 2600  
St. Louis, Missouri 63102-2740



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eugene A. Fusz : Art Unit: 3623  
Serial No.: 09/426,954 : Examiner: Boyce, Andre D.  
Filed: October 26, 1999 :  
For: METHODS AND APPARATUS FOR :  
ANONYMOUS DATA PROFILING :

## APPELLANT'S REPLY BRIEF

Mail Stop: Appeal Brief - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In the Examiner's Answer, it is indicated that Claims 1, 3-17, 19-26, and 28 are rejected as being unpatentable over Goldhaber et al. (USPN 5,855,008) in view of Kepecs (USPN 6,009,411).

Applicant contends that the Goldhaber and Kepecs patents, alone or in combination, neither anticipate nor render obvious Applicant's claimed invention as a matter of law. The Examiner's Answer argues that both Goldhaber and Kepecs are concerned with an effective method of marketing products to potential consumers, for example, at page 5, lines 3 and 4 of the Examiner's Answer. This rationale is used again at page 12, lines 19-21 as the suggestion to combine the references. However, Goldhaber describes brokering the attention of consumers by buying and selling that attention. Stated simply, Goldhaber pays people to look at advertisements on their computers. More specifically, by building consumer profiles, Goldhaber is able to target the proper consumers for the advertisements to be viewed. Registration of consumers in the system of Goldhaber includes entering personal information, such as names, addresses, telephone numbers, etc.

Kepecs is not directed to the development of consumer profiles for targeted viewing of advertisements. Rather, Kepecs describes the offering of discounts to customers that have registered their keys with one or more retailers. In Kepecs, an intermediate device, referred to as a discount administration process (DAP) computer uses “keys” to notify customers of discounts that are available to them. However, to receive these discounts, a consumer must register their key with a retailer. The consumer uses their key to access, through their computer, information regarding discounts available to them.

In any event, though Kepecs uses the term “profile”, the term as used is limited to a purchasing history. Therefore, since Kepecs does not appear to be directed towards the generation of consumer profiles, Applicant submits that there is no motivation to be found within the references suggesting the combination of Goldhaber et al. and Kepecs.

As such, Applicant respectfully submits that the pending rejections are not proper section 103(a) rejections. More specifically, where the Office has not identified any motivation and suggestion of advantages, a Section 103 rejection cannot stand. See, *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness “only by showing some objective teaching” leading to the modification); *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989) (“the mere fact that the prior art could be modified” to form a claimed structure “would not have made the modification obvious unless the prior art suggested the desirability of the modification”) (numerous citations omitted); *In re Serriaker*, 702 F.2d 989, 995-96 (Fed. Cir. 1983) (reversing Board of Appeal disallowance of application because “prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings”).

The mere fact that each of the elements might be found in a reference and has previously known benefits does not provide the requisite “motivation” or “incentive” to modify the teachings of a reference. E.g., *Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 959 (Fed. Cir. 1986) (“That each element in a claimed

invention is old or unpatentable does not determine the nonobviousness of the claimed invention as a whole. There is no basis in law for treating combinations of old elements differently in determining patentability") (citation omitted).

Rather, the test for obviousness is based on what one skilled in the art would know *as of the time of the invention*, not what a specialist (such as the Examiner) can determine using the "20-20 hindsight" available from the years of development of the field since the invention date. *E.g., In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999) ("Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field," and "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"); *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) ("the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher").

For these reasons, all claims should be in condition for allowance, independent of additional reasons discussed below.

Now referring to the specific rejections, in various embodiments, the DAP computer is connected to retailer's computers, retailer's financial institution computers and the consumer's financial institution computers. Accordingly, such a system is not anonymous. In the Examiner's answer, at page 11, lines 17-22 it is asserted that the lowest level of identification as described by Kepecs is system wide. In reality, Applicant submits that this lowest level of identification refers only to the DAP computer portion of the Kepecs system. To support Applicant's contention, Kepecs states that a consumer can be completely anonymous to the DAP computer, even if the key has non-anonymous bindings elsewhere. Presumably these non-anonymous bindings refer to the

connections to, for example, a consumer account in one of the above listed computer systems (e.g., the consumer's financial institution).

If the system of Kepecs is able to receive a credit to his account as described at Column 4, lines 7-9, it is implausible to maintain that the consumer is anonymous. Applicant respectfully submits that the interconnections to the other systems compromises the ability of the DAP computer to maintain an anonymity of the consumer. Still further, it is respectfully submitted that an inability to accept contact information is not analogous to a possibility of remaining anonymous to a computer system and is neither anticipated by, nor obvious in view of such a computer system.

With respect to at least Claims 1, 8 and 16, the Examiner maintains that Goldhaber et al. discloses the elements of the claimed invention except for maintaining the anonymity of an individual through an inability to accept contact information in the profile. The Examiner further states that Kepecs discloses a method of distributing and redeeming promotions wherein no consumer identification is maintained. More specifically, it is stated that the lowest level of identification in Kepecs is simply a unique customer key with no other identification data.

As indicated above, the DAP computer is connected to other computers to which the consumer is not anonymous. Therefore, attempting to remain anonymous at the DAP computer would be difficult at best, if not impossible. In addition, it is respectfully submitted that an inability to accept contact information is not analogous to a possibility of remaining anonymous to a computer system. Kepecs never states that the DAP computer is unable to accept contact information. Rather, it is stated that no "direct consumer identification is maintained in the consumer account", where the consumer account referred to in this instance is the consumer's account with the DAP computer that is identified by the key.

With respect to at least Claim 22, the Examiner maintains that Goldhaber et al. discloses the elements of the claimed invention except for refusing a name, an address,

and a social security number entry for the consumer. The Examiner further states that Kepecs discloses distributing and redeeming promotions where no contact information is maintained. More specifically, it is stated that the lowest level of identification in Kepecs is simply a unique customer key with no other identification data. However, not maintaining contact information does not render obvious refusing entry of such information.

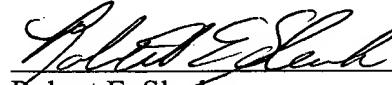
As recited above, the DAP computer is connected to other computers where the consumer is not anonymous. Therefore, it would seem that attempting to remain anonymous at the DAP computer would be difficult at best, if not impossible. Kepecs never states that the DAP computer is able to refuse entry of contact information. Rather, it is stated that no "direct consumer identification is maintained in the consumer account", where the consumer account referred to in this instance is the consumer's account with the DAP computer that is identified by the key.

In summary, throughout the Examiner's Answer it is repeatedly implied that "the lowest level of identification" as described in Kepecs refers to system wide anonymity. Applicant respectfully submits, as described above, that such a contention is incorrect. When Kepecs refers to the "lowest level of identification" it is with respect to the DAP computer only. Throughout Kepecs there are references to accounts with financial institutions. These are the non-anonymous bindings that are referred to in the paragraph at Column 6, lines 52-59. Now referring back to Column 5, lines 38-42, "[t]he DAP computer 11 may also be connected to the computer 24 of the consumer's financial institution (CONFIT). This connection allows credit obtained by the purchase of discounted goods to be placed in the consumer's account at the consumer's financial institution..." Again, when Kepecs refers to the "lowest level of identification", that is, "the KEY with no other identification data" it is with respect to the DAP computer only. Applicant respectfully submits that identification using a key, even if such a key is anonymous, does not imply an inability to accept contact information.

Finally, Applicant respectfully submits that more than five years have passed since the filing of the currently pending application. This is also the amount of time that has passed since issuance of the Kepecs patent. In that time, as far as the Applicant is aware, no third party has produced a product or description of a product, that appears to combine the teachings of the Goldhaber and Kepecs patents. Applicant believes that if the disclosures of Goldhaber and Kepecs provide a motivation for combination, such a product or system would currently be available. In summary, Applicant respectfully submits that other than the disclosure of the Applicant's patent application, no one piece of prior art, or combination of prior art, provides, or renders obvious, the anonymous data profiling aspects claimed by the Applicant in the presently pending application.

Accordingly, for all of the reasons given above, Applicant respectfully submits that Claims 1, 3-17, 19-26, and 28 are patentable over Goldhaber et al. in view of Kepecs. Further, Applicant respectfully requests that the Section 103 rejections of all of Claims 1, 3-17, 19-26, and 28 in this Appeal should be withdrawn and that these claims should be allowed. A favorable decision by the Board is respectfully solicited.

Respectfully Submitted,



Robert E. Slenker  
Robert E. Slenker  
Registration No. 45,112  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070